

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker *et al.*
Application No.: 09/994,810
Filed: November 27, 2001
Title: METHOD AND APPARATUS FOR UTILIZING DEMAND
INFORMATION AT A VENDING MACHINE

Attorney Docket No.: 01-050

Group Art Unit: 3621
Examiner: Cristina O. Sherr

**PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Final Office Action mailed January 6, 2006**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed October 4, 2006 as Part of Paper No./Mail Date 20060915 (hereinafter the "Final Office Action"). No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth in the remarks beginning on the following page.

REMARKS

I. Introduction

Claims 1-2, 6-9, 17, 30-34, 51-61, 76-82, and 84-95 are currently pending in the present application. Claims 1, 32, 53, 76, and 92-95 are independent. The Examiner indicates that claim 93 *is allowable* (the Examiner has previously indicated that claims 53-61 are allowable, and then apparently has reversed this indication), and all other claims stand rejected. In particular:

(A) claims 76-81 stand rejected under the allegedly judicially-created doctrine of non-statutory obviousness-type double patenting (hereinafter simply “Double Patenting”) in view of various claims of U.S. Patent No. 6,324,520 (hereinafter “Walker”);

(B) claims 92 and 94¹ stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement;

(C) claims 1-2, 6-9, 14², 17³, and 30-31 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over WO 97/28510 A1 (hereinafter “Smith”) in view of U.S. Patent No. 5,802,015 (hereinafter “Rothschild”); and

(D) claims 32-34, 51-52, 76-82, 84-91, and 95 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Smith in view of U.S. Patent No. 5,029,098 (hereinafter “Levasseur”).

II. The Examiner’s Rejections

A. Double Patenting Rejections

The Examiner indicates that all double patenting rejections are overcome and withdrawn (Final Office Action, pg. 2, bullet 2), but then goes on to state that claims 76-

¹ The Examiner lists claim 95 as being rejected under this ground for rejection, however, as the feature alleged by the Examiner to lack written description support does not exist in claim 95, and claim 94 does recite such a feature, Applicants assume the Examiner intended claim 94 to be rejected under this ground for rejection.

² Although the Examiner does not list claim 14 as being rejected under this ground for rejection, the Examiner appears to later address claim 14 utilizing this ground of rejection, Applicants therefore address claim 14 herein with respect to this ground for rejection.

³ Claim 17, while also not being listed by the Examiner as being rejected under this ground for rejection, appears to also to be later addressed with respect to this ground for rejection, Applicants also therefore address claim 17 herein with respect to this ground for rejection.

81 are rejected under obviousness-type double patenting over Walker (Final Office Action, pg. 10, bullet 18).

Applicants assume that the paragraph that presumably maintains the double patenting rejections with respect to claims **76-81** has been erroneously included in the Final Office Action, particularly because the same paragraph also refers to a typographical error in claim **80** that was corrected in Applicants' previous Response. If the paragraph is not presented in error, Applicants respectfully note that no reasoning is provided for maintaining such a double patenting rejection in light of the terminal disclaimer that has been filed and entered. Accordingly, the outstanding double patenting rejections of claims **76-81** should be reversed.

B. 35 U.S.C. §112, first paragraph Rejections

The Examiner asserts (with respect to claim **92**) that "nothing in the specification refers to upsell prices or round-up prices." Final Office Action, pgs. 10-11, bullet 21. Applicants respectfully note, however, that support and description of both upsell and round-up prices is incorporated by reference into Applicants' specification, as filed (pg. 1, lines 4-12), from U.S. Patent Application Serial No. 09/012,163, which issued as U.S. Patent No. 6,397,193 on May 28, 2002.

The Examiner asserts (with respect to claim **94**) that "nothing in the specification refers to operator access codes." Final Office Action, pgs. 10-11, bullet 21. Applicants respectfully note, however, that the method of claim **94** is fully and adequately described at least with respect to FIG. 7 and the descriptions related thereto (pg. 15, lines 3-31), in Applicants' specification as filed.

Accordingly, as all claimed concepts are properly described and supported by Applicants' specification as filed, the §112, first paragraph rejections of claims **92** and **94** should be reversed, and, in the absence of any outstanding prior art rejections of these claims, they should be summarily allowed.

C. 35 U.S.C. §103(a) Rejections – Smith, Rothschild

Applicants respectfully note that the Examiner, despite responding in general to Applicants' arguments set forth in the previous Response, has neglected to address

Applicants' argument that neither Smith nor Rothschild teaches or suggests: *a substitute product identifier corresponding to the substitute product* (claims **1-2**, **6-9**, **17**, and **30-31**). Applicants arguments on this point presented in the previous Response are hereby incorporated by reference herein to avoid undue repetition. In short, however, the Examiner agrees that neither reference teaches such a limitation expressly, but contends that such a limitation is *implicit* in Smith. Applicants have set forth arguments showing how such a limitation, while possibly *usable* in Smith, is not necessary, or even likely, for Smith to function.

The Examiner further fails to address how the Examiner's argument that "it would be obvious that expiration date is a factor in availability of a product" (Final Office Action, pg. 3, lines 1-2), is believed to be related to the pending claims – which do not recite expiration date being a factor in product availability. Applicants' arguments from the previous Response describing how such a statement is not germane to the limitation: *determining a substitute product comprising one of the plurality of products associated with the earliest of the determined expiration dates* (claims **1-2**, **6-9**, **17**, and **30-31**), are hereby incorporated by reference herein to avoid undue repetition.

The Examiner further fails to address Applicants' arguments from the previous Response (hereby incorporated by reference herein) relating to how the limitation: *recording a value corresponding to the selection of the first product* (claims 7-8) is not taught or suggested by the cited references. In short, prior art systems have not been found to record mere product selections, but instead, record product sales, which is an entirely different metric, potentially useful for entirely different purposes.

Nor has the Examiner provided convincing arguments or any evidence on the record supporting the contention that it would be obvious to effectuate an *offering, in consideration of the consumer's acceptance of the substitute product, the substitute product to the consumer at a discounted price* (claim **17**).

At least for these reasons, the §103(a) rejections of claims **1-2**, **6-9**, **14**, **17**, and **30-31** should be reversed.

D. 35 U.S.C. §103(a) Rejections – Smith, Levasseur

Applicants respectfully note that the Examiner has failed to address Applicants' arguments from the previous Response (hereby incorporated by reference herein) describing how the cited references fail to teach, suggest, or render obvious: *determining from the demand a substitute product for a first product* (claims **32-34, 51-52, 76-82, and 84-91**). In particular, the Examiner has failed to address the fact that combining the two references would simply not result in the embodiments as currently claimed.

III. Unaddressed Limitations

Applicants respectfully note that the Examiner has continued to fail to address limitations of the pending claims, such as those pointed out to the Examiner in the previous Response, at pg. 22, Section IV, items (i), (ii), and (iii); which are hereby incorporated by reference herein.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all claims are clearly in condition for allowance and Pre-Appeal Brief Review is requested to avoid the unnecessary expense of preparing an Appeal Brief in relation to the current rejections.

If there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via e-mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,

December 4, 2006

Date

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